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In the

Supreme Court of the United States

OCTOBER TERM, 1957

No. [redacted] 70

THOMAS E. BRYAN,

Petitioner,

v.

SID W. RICHARDSON, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE FIFTH CIRCUIT

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May, 1958

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Thomas E. Bryan, respectfully prays that a Writ of Certiorari issue to the Court of Appeals for the Fifth Circuit to review the Judgment of that Court holding valid and infringed claims 1, 4 and 6 of United States Letters Patent No. 2,664,162. A certified copy of the record, including all proceedings in the Court of Appeals for the Fifth Circuit, is furnished herewith in compliance with Rule 31, subdivision 2, of the rules of this Court.

JURISDICTION OF THE COURTS BELOW

This suit was commenced in the United States District Court for infringement of Letters Patent of the United States. The jurisdiction of the District Court was founded on 28 U. S. Code Sec. 1338. The jurisdiction of the Court of Appeals for the Fifth Circuit was founded on 28 U. S. Code Sec. 1292, subdivision (4).

OPINION OF THE COURT BELOW

Copies of the opinion (R. 1668) of the Court of Appeals for the Fifth Circuit and the Judgment (R. 1685) upon which review is respectfully sought are appended in Appendix I to this petition. The opinion is reported at 110 USPQ 424, but at the time of preparation of this petition had not been reported in the Federal Reporter.

CONCISE STATEMENT OF GROUNDS UPON WHICH THE JURISDICTION OF THIS COURT IS INVOKED

The grounds on which jurisdiction is invoked is that the Court of Appeals for the Fifth Circuit, by its Judgment, has decided important questions of Federal law in a way in conflict with applicable decisions of this Court and Courts of Appeals of other circuits and has erroneously construed and applied a statute of the United States, to-wit, *35 U. S. Code Sec. 112.*

The Judgment of the Court of Appeals for the Fifth Circuit sought to be reviewed was entered on April 8, 1958

and this petition is filed in this Court within ninety (90) days following such entry.

The statute conferring jurisdiction on this Court is *28 U. S. Code Sec. 1254.*

QUESTIONS PRESENTED

1. Is the doctrine of the cases of *General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 58 S. Ct. 899,* and *Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 67 S. Ct. 6,* precluding the use of indefinite and functional language at the exact point of novelty and invention in a claim of a patent, overruled by the third paragraph (added to R. S. §4888, 35 U. S. Code Sec. 33 by the Patent Act of 1952) of *35 U. S. Code Sec. 112,*[1] so that so-called combination claims may now define the gist of the invention at the exact point of novelty and invention solely by "means" plus a statement of function?

2. Does the last paragraph of *35 U. S. Code Sec. 112* (added to former R. S. §4888, 35 U. S. Code Sec. 33, by the Patent Act of 1952) so modify or restrict the first portion thereof (which was formerly Section 4888, R. S., 35 U. S. Code Sec. 33), so that a patent claim in combination form may now define the gist of the invention at the exact point of novelty and invention by the indefinite and functional language "means" plus a mere statement of function?

[1] Not previously before this court in its present form as enacted by the Patent Act of 1952, as far as we can determine.

STATUTES TO BE CONSIDERED

The pertinent portion of the statute in force prior to Patent Act of 1952, which was *Section 4888 Revised Statutes, 35 U. S. Code Sec. 33*, is as follows:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The pertinent portions of the present statute which was substituted for *35 U. S. Code Sec. 33* by the Patent Act of 1952 as *35 U. S. Code Sec. 112* are as follows:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. July 19, 1952, c. 950 §1, 66 Stat. 798."

This latter or third paragraph of the new statute was added to the substance of former *35 U. S. Code Sec. 33*.

CONCISE STATEMENT OF THE CASE

This suit was brought by respondent against petitioner for infringement of two United States patents issued to respondent as the assignee of the applicants for the patents; Patent No. 2,664,162, dated December 29, 1953 (R.

959), and Patent No. 2,679,903, dated June 1, 1954 (R. 1039). Only claims 1, 4 and 6 of Patent No. 2,664,162 and claims 1 to 4, inclusive, of Patent No. 2,679,903 were sued upon. The District Court adjudged all these claims to be valid and infringed, and this Judgment was affirmed on appeal to the Court of Appeals for the Fifth Circuit. This petition seeks a review of the Judgment affirming the Judgment of the District Court that claims 1, 4 and 6 of Patent No. 2,664,162 are valid as a matter of law.

Patent No. 2,664,162 is concerned with the positioning and removal of self-contained gas injection valves in the production tubing or pipe in an oil well to inject gas to lighten the oil column entering the tubing from the formation and enable it to rise to the surface and discharge. This art of gas lifting of oil is a very old one and the patent is concerned only with the installing and removal of such valves from the tubing.

Prior to the patents in suit, the tubing was provided with enlarged "mandrels" or sleeves, each having a seat to receive and hold a gas injection valve. In one prior type the gas injection valve was mounted in a seat in the mandrel or sleeve in an eccentric position relative to the interior bore of the production tubing prior to installing the tubing in the well and if it was desired to change valves, the tubing had to be removed from the well and the valve replaced. In a second type, the mandrel or sleeve had a seat at its axial center which would removably receive a gas injection valve and wire line means were provided for removing and replacing the valve with the tubing remaining in situ. This

had the disadvantage that if a lower valve was to be removed, the valves above it had to first be removed and then all the valves repositioned. Also, it did not leave the entire tubing bore open as did the earlier fixed in place eccentrically positioned valves of the first mentioned type.

What the patentees of Patent No. 2,664,162 did was to move the concentric valve seat of the second type to the eccentric position of the first type, then provide a wire line tool which could be operated in the tubing to shift laterally to place a valve in the eccentric seat or remove it therefrom --overcoming the disadvantage of the fixed eccentric type and the disadvantages of the removable concentric type.

Upon this improvement, the patentees were issued five different sets of patent claims in three patents. The only claims involved here are claims 1, 4 and 6 of Patent No. 2,664,162, of which claim 1 is typical and is here set out:

> "In combination with a well tubing having a vertical main bore, said tubing including one or more flow valve receiving sections each having a portion laterally offset from the vertical main bore and provided with a flow valve seat in the offset portion, and means, including a shifting tool adopted to be lowered from the top of the tubing to the level of a selected section, for selectively seating or removing a flow valve in or from its seat within a selected receiving section, said shifting tool being provided with means for moving said tool and its appendages laterally within the offset portion of the selected section."

The main contention as to the invalidity of these claims below was that they, by their language, included all known and unknown means to accomplish the result and therefore

were fatally indefinite and functional under the doctrine of *General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 58 S. Ct. 899, Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 67 S. Ct. 6,* and *35 U. S. Code Sec. 112,* for the reason that what breathed life into these claims and what constituted the gist of the claimed invention and the exact point of novelty and invention was expressed in the claim solely by "means" followed only by a statement of function as follows:

> "* * * and means, including a shifting tool adapted to be lowered from the top of the tubing to the level of a selected section for selectively seating or removing a flow valve in or from its seat within a selected section, said shifting tool being provided with means for moving said tool and its appendages laterally within the offset portion of the selected section."

The Court below rejected this contention and opined that such a claim was expressly authorized by *35 U. S. Code Sec. 112,* stating: "If *Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 91 L. Ed. 3,* caused either a real or psychosomatic infirmity in the body of the prior law, it is plain that Section 112 was meant as a sufficient transfusion to restore vitality to the principles before and since pronounced."

REASONS RELIED UPON FOR THE ALLOWANCE OF WRIT OF CERTIORARI

1. That issues of great moment to the public are involved in that the Court of Appeals for the Fifth Circuit has, by

ruling claims 1, 4 and 6 of Patent No. 2,664,162 to be valid, under the authority of the last paragraph of *35 U. S. Code Sec. 112* (which paragraph was added by the Patent Act of 1952 to former Section 4888 of the Revised Statutes, 35 U. S. Code Sec. 33), made a ruling in direct conflict with the decisions of this Court in *General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 58 S. Ct. 899*, and *Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 67 S. Ct. 6*, and in direct conflict with this Court's interpretation of a federal statute, former *35 U. S. Code Sec. 33, now 35 U. S. Code Sec. 112*, and in so doing ruled in effect that a patent claim which is combination in form may use such indefinite and functional language as "means" plus a statement of function at the exact point of novelty and invention, and thus:

(a) deprive the public of being clearly informed "during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used without a license and which may not." (Quoted from *United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 63 S. Ct. 165.)*

(b) deprive the public of protection against a patent monopoly on *an idea or result* rather than *the structural embodiment* of the invention, and thus retard the promotion of the progress of science and useful arts which is the dominant concern of the patent system, as stated in *Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 48 S. Ct. 474*, and *United States v. Masonite Corp., 316 U. S. 265, 62 S. Ct. 1070.*

(c) deprive the public of protection against the evil stated by this Court in *Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 67 S. Ct. 6,* as:

> "In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. * * *."

2. That the Court of Appeals for the Fifth Circuit, by ruling claims 1, 4 and 6 of Patent No. 2,664,162 to be valid, under the authority of the last paragraph of *35 U. S. Code Sec. 112* (which paragraph was added by the Patent Act of 1952 to former Section 4888 of the Revised Statutes, 35 U. S. Code Sec. 33) made a ruling with respect to *35 U. S. Code Sec. 112* in conflict with decisions of Courts of Appeals in other circuits, particularly the Court of Appeals for the First Circuit and the Court of Customs and Patent Appeals, which latter courts have ruled that *35 U. S. Code Sec. 112* must be considered in its entirety, and when so considered, patent claims which define the exact point of novelty and invention by expressions in such indefinite and functional language as "means" plus a statement of function do not comply with the statute and are invalid.

3. That this Court, in the public interest and in the interest of uniformity of ruling and of law throughout the various circuits, should construe *35 U. S. Code Sec. 112*, Act of July 19, 1952, c. 950, §1, 66 Stat. 798, and its effect

on patent claims which are combination in form but which use indefinite and functional statements at the exact point of novelty and invention.

ARGUMENT

1. Claims 1, 4 and 6 of Patent No. 2,664,162 are fatally indefinite and functional under the doctrine of General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 58 S. Ct. 899, Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 67 S. Ct. 6, and 35 U. S. Code Sec. 112, and the Judgment holding the claims to be valid is in direct conflict with those cases and that statute.

Claim 1 of Patent No. 2,664,162 is typical of all three of the claims involved here and we here segregate the elements thereof with our commentation:

Claim 1 of Patent No. 2,664,162	Commentary
(a) In combination with a well tubing	(a) This is, of course, an old element of the combination.
(b) said tubing including one or more flow valve receiving sections	(b) This is the old and usual arrangement of gas lift flow valves in a tubing.
(c) each (section) having a portion laterally offset from the vertical main bore and provided with a flow valve seat in the offset portion	(c) This does not define anything novel over the prior art because the language precisely describes old flow valve receiving sections patented as early as 1940; for example, the Kyner patent '247 (R. 1198), shows a well tubing, a flow

valve receiving section having a portion offset from the main bore and provided with a flow valve seat in the offset portion. Consequently, this element as defined in the claim adds no patentable novelty to the claim. (Also, it includes any and all flow valve receiving sections, so long as they have an offset portion and a flow valve seat therein.)

(d) and means, including a shifting tool adapted to be lowered from the top of the tubing to the level of a selected section for selectively seating or removing a flow valve in or from its seat within a selected section

(d) Except that it denominates the "means" as a "shifting tool," the claim does not characterize it by any effective structural or operational limitations, but describes it solely in terms of its function or result.

(e) said shifting tool being provided with means for moving said tool and its appendages laterally within the offset portion of the selected section.

(e) This use of a shifting tool capable of being laterally shifted to insert or remove a flow valve is what breathes life into the claim and, consequently, therein is the exact point of novelty and invention in the patent claim albeit the shifting tool is described solely in terms of its use and the result accomplished. To argue otherwise appears without basis.

Claims 4 and 6 merely append to claim 1—in claim 4, well-known "jars" with the usual function of jars—in claim 6, "wherein the flow valve seat is formed in a flat base portion of each of the flow valve receiving sections."

Thus, these two latter claims 4 and 6 must stand or fall as far as validity is concerned with claim 1. Our argument, while specifically directed to claim 1, applies to claims 4 and 6 as well and to an equal degree.

That such claims express and define the invention purely by functional statements, and are so broadly stated and so wholly without effective limitations that they include in their language every known or unknown apparatus which may be used to accomplish the function and result, is apparent from the claims themselves.

It is inconceivable how a gas lift valve could be moved to and installed in a laterally offset position within a well pipe unless it is shifted laterally by some "means," whether called a "shifting tool" or not. Thus, the claims cover all means for accomplishing the result and the public is deprived of the efforts of other inventors and the benefit of subsequent inventions.

2. The Court of Appeals for the Fifth Circuit in holding such claims valid and as complying with 35 U. S. Code Sec. 112, has rendered a decision in direct conflict with the decisions of this Court in General Electric Co v. Wabash Appliance Corp., 304 U. S. 364, 58 S. Ct. 899, and Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 67 S. Ct. 6, and in conflict with 35 U. S. Code Sec. 112.

In the *General Electric Co. v. Wabash Appliance Corp.* case, this Court, speaking through Mr. Justice Reed, said:

> "The claim uses indeterminate adjectives which describe the function of the grains to the exclusion of

> any structural definition, and thus falls within the condemnation of the doctrine that a patentee may not broaden his product claims by describing the product in terms of function. (Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 256-258, 72 L. Ed. 868, 872, 873, 48 S. Ct. 474, and cases cited.) Claim 25 vividly illustrates the vice of a description in terms of function. 'As a description of the invention it is insufficient and if allowed would extend the monopoly beyond the invention.' (277 U. S. at 258.) The Court of Appeals for the Ninth Circut relied on the fact that the description in the claims is not 'wholly' functional. 80 F. 2d 958, 963. But the vice of a functional claim exists not only when a claim is 'wholly' functional, if that is ever true, but also when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty. [See Gynex Corp. v. Dilex Institute (C. C. A. 2d) 85 F. 2d 102, 105; Davis Sewing Mach. Co. v. New Departure Co. (C. C. A. 6th) 217 F. 775, at 782.]" 304 U. S. 364, 371, 82 L. Ed. 1402, 1406-1407.

In the *Halliburton Oil Well Cementing Co. v. Walker* case, this Court applied the same rule to a "combination" claim, stating:

> "For our purpose in passing upon the sufficiency of the claims against prohibited indefiniteness we can accept without ratifying the findings of the lower court that the addition of 'a tuned acoustical means' performing the 'functions of a sound filter' brought about a new patentable combination, even though it advanced only a narrow step beyond Lehr and Wyatt's old combination. * * *."

The Court then turned to the consideration of whether the claim in suit was valid, and held the claim invalid, saying:

> "* * * We must, however, determine whether, as petitioner charges, the claims here held valid run afoul

of Rev. Stat. §4888 because they do not describe the invention but use 'conveniently functional language at the exact point of novelty.' General Electric Co. v. Wabash Appliance Corporation supra, 304 U. S. at page 371, 58 S. Ct. at page 903, 82 L. Ed. 1402.

* * * * *

"A claim typical of all those held valid only describes the resonator and its relation with the rest of the apparatus as 'means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing section to clearly distinguish the echoes of said couplings from each other.' The language of the claim thus describes this most crucial element in the 'new' combination in terms of what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus. We have held that a claim with such a description of a product is invalid as a violation of Rev. Stat. §4888. Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 256, 257, 48 S. Ct. 474, 478, 479, 72 L. Ed. 868; General Electric Co. v. Wabash Appliance Corporation, supra. * * *"

The Court laid emphasis on the evils of the claim, as far as the public interest is concerned, as follows:

"* * * In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. See United Carton Co. et. al. v. Binney & Smith Co., 317 U. S. 228, 236, 63 S. Ct. 165, 170, 87 L. Ed. 232; Burr v. Duryee, 1 Wall. 531, 568, 17 L. Ed. 650; O'Reilly et al. v. Morse et al., 15 How. 62, 112, 113, 14 L. Ed. 601. Yet if Walker's blanket claims be valid,

no device to clarify echo waves, now known or hereafter invented, whether the device be an actual equivalent of Walker's ingredient or not, could be used in a combination such as this, during the life of Walker's patent."

The claims of Patent No. 2,664,162 here involved and the condemned Halliburton claims are, in legal contemplation, precisely alike, and we here make a comparison:

A condemned Halliburton claim	Typical claim 1 of Patent No. 2,664,162 involved here
(a) In an apparatus for determining the location of an obstruction in a well having therein a string of assembling tubing sections inter-connected with each other by coupling collars, means communicating with said well for creating a pressure impulse in said well, echo receiving means including a pressure responsive device exposed to said well for receiving pressure impulses from the well and for measuring the lapse of time between the creation of the impulse and the arrival at said receiving means of the echo from said obstruction	(a) In combination with a well tubing, said tubing including one or more flow valve receiving sections, each (section) having a portion laterally offset from the vertical main bore and provided with a flow valve seat in the offset portion
(NOTE): Then follows the gist of and exact point of novelty and invention in indefinite and functional language.	(NOTE): Then follows the gist of and exact point of novelty and invention in indefinite and functional language.
(b) and means associated with said pressure responsive device for tuning said	(b) and means, including a shifting tool adapted to be lowered from the top of the

receiving means to the frequency of echoes from the tubing collars of said tubing sections to clearly distinguish the echoes from said couplings from each other.

tubing to the level of a selected section for selectively seating or removing a flow valve in or from its seat within a selected section,

(c) said shifting tool being provided with means for moving said tool and its appendages laterally within the offset portion of the selected section.

This Court's statements in the *Halliburton* case above quoted apply equally to the claims in issue in that no removable offset gas valve device can possibly be produced without some means which can be shifted laterally to move the valve to and from an eccentric position to install and remove the valve.

Thus, the Court of Appeals for the Fifth Circuit, in holding claims 1, 4 and 6 of Patent No. 2,664,162 valid, has rendered a decision in conflict with the applicable decisions of this Court and the statute *35 U. S. Code Sec. 112*, and contrary to the public interest.

3. The decision of the Court of Appeals for the Fifth Circuit here involved is contrary to the public interest.

The present claims clearly are so "indefinite as not to give the notice required by statute" and to sustain them would "be in direct contravention of the public interest which Congress recognized and sought to protect." *(United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 63 S. Ct. 165, 167.)*

This Court recognized in the *Halliburton* case that granting claims of such type may stifle further progress rather than promote it.

Certainly, as this Court has many times held, the public is entitled to know the exact metes and bounds of a patent monopoly so that it may know what it can and what it cannot make and use without infringing. *(United States v. Masonite Corp., 316 U. S. 265, 62 S. Ct 1070; United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 63 S. Ct. 165, 167; Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 48 S. Ct. 474; O'Reilly v. Morse, 15 How. 62, 14 L. Ed. 601.)*

The decision of the Court of Appeals for the Fifth Circuit in this matter emphasizes the intrusion on the public domain of such broad, indefinite and functional claims. The patentees of Patent No. 2,664,162 have three patents and five sets of claims directed to the devices of Patent No. 2,664,162. These patents are Patent No. 2,664,162 (R. 959), Patent No. 2,679,903 (R. 1039) and Patent No. 2,679,904 (R. 1223).

Patent No. 2,664,162, upon which relief is sought, shows two totally different forms of shifting tool for shifting the valve laterally into and out of the receiving seat. The first, which is the electromagnetic form, is claimed[2] in claims of

[2]Claim 3: In combination with a well tubing having a section provided with a laterally offset seat or a flow control unit having a mass of magnetic material in the wall thereof on the same side of the tubing axis as the seat, means including a shifting tool, adapted to be lowered into said well, for installation or removal of a flow control unit, said tool carrying an electromagnet adopted to coact with said mass of magnetic material for laterally deflecting the tool toward said seat when the tool is lowered approximately to the level of said seat to permit installing or removing a flow control unit.

Patent No. 2,679,904 (R. 1223), and *petitioner was not charged to infringe the same.*

The second form (mechanical shifting) is claimed[3] in claims 5 to 9, inclusive, of Patent No. 2,679,903 (R. 1039), *and petitioner was not charged to infringe such claims.*

However, the third patent here involved includes the three blanket claims charged to be infringed, which are so broad they include not only the separately patented electromagnetic form of Patent No. 2,679,904 and the separately patented mechanical form of Patent No. 2,679,903, *but the later invented patentable*[4] *accused device of petitioner.* Surely, this is ample evidence that the claims in issue are so broad, ambiguous and indefinite "as not to give the notice required by the statute * * * in direct contravention of the public interest * * *."

1. The decision of the Court of Appeals for the Fifth Circuit, holding claims 1, 4 and 6 of Patent No. 2,664,162 valid, is in direct conflict with provisions of 35 U. S. Code Sec. 112 and applicable decisions of the Court of Appeals for the First Circuit and Court of Customs and Patent Appeals.

The Court of Appeals for the Fifth Circuit held that the claims here involved fully complied with *35 U. S. Code Sec.*

[3] Claim 5: For use with a well tubing having a laterally offset portion therein, a flow control unit handling tool comprising a main elongate body portion having spring-pressed outwardly expansible centralizing means slidably positioned thereon, and co-engageable latching means on the forward portion of the main body of the tool and on the centralizing means at the forward end of the body, said centralizing means when latched serving to deflect the tool into the offset of the tubing.

[4] The Patent Office ruling that the accused apparatus was patentable over the patents in suit appears at R. 1126. The patent actually issued as Patent No. 2,828,698 on April 1, 1958, with twenty-nine claims, but was issued too late to become part of the record below.

112. In support of this decision, the Court seemingly adopted the reasoning of the District Court (Opinion R. 835, at 843), wherein the District Court said:

> "* * * I cannot agree with defendant's counsel that no significance, other than to restate existing law, is to be attached to the added language in section 112 of the Patent Act of 1952. Rather, I think, it was to return to the *principles* enunciated in the Paper Bag and other cases from which, some must have feared, the court had departed in the Halliburton case, 329 U. S. 1, 67 S. Ct. 6. Personally, I do not believe there was a just basis for that fear since the Court, before the amendment, again recognized in Faulkner v. Gibbs, 338 U. S. 267, 70 S. Ct. 25, propriety of the use of functional language in combination patents * * *. There *is* room for argument that the principles may have been misapplied in Halliburton."

because in support of its decision, the Court of Appeals for the Fifth Circuit used as an authority (among others) for its proposition the following:

> "Commentary" [which appears as an Introduction to Title 35 (35 U. S. C. A., pp. 1-70), by the Examiner in Chief U. S. Patent Office].

wherein at page 25, it is said:

> "* * * It is unquestionable that some measure of greater liberality in the use of functional expressions in combination claims is authorized than had been permitted by some court decisions, and that decisions such as that in Halliburton Oil Well Cementing Co. v. Walker, 67 S. Ct. 6, 329 U. S. 1, 91 L. Ed. 3 (1946), are modified or rendered obsolete, but the exact limits of the enlargement remain to be determined. The language specifies 'an' element, which means 'any' element * * *."

The *General Electric Co. v. Wabash* case and *Halliburton Oil Well Cementing Co. v. Walker* case, and many others, clearly held that indefinite and functional claims do not comply with R. S. §4888 (35 U. S. Code Sec. 33) now embodied in *35 U. S. Code Sec. 112*. Thus, if such claims are now permitted by *35 U. S. Code Sec. 112*, it must be by virtue of the added paragraph 3 of that statute, which provides:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. July 19, 1952, c. 950 § 1, 66 Stat. 798."

To justify such conclusion, former R. S. §4888, *35 U. S. Code Sec. 33*, must be considered as modified or dominated by the added paragraph to an extent that it now overrules the line of cases headed by the *General Electric Co. v. Wabash Appliance Corp.* case and the *Halliburton Oil Well Cementing Co. v. Walker* case, and now validates patent claims which formerly violated that statute.

We urge that this construction of the statute by the Court of Appeals for the Fifth Circuit is in error and in conflict with the former decisions of this Court respecting former *35 U. S. Code Sec. 33* and the present statute *35 U. S. Code Sec. 112*. The new paragraph does not modify or limit the rule of the *General Electric Co. v. Wabash Appliance Corp.* case or *Halliburton Oil Well Cementing Co. v. Walker*, based on former R. S. §4888, *35 U. S. Code*

Sec. 33, but merely codifies the previous case law that "means" followed by a statement of function may, in certain limited instances, be properly used. The rule is best stated in *Davis Sewing Machine Co. v. New Departure Mfg. Co., 217 F. 775*, as follows:

> "Reliance is also placed upon the opinion of this Court, speaking by Judge (afterwards Mr. Justice) Lurton, in Tyden v. Ohio Table Co., 152 Fed. 183. In this case, the claim calling for 'means' was held invalid because it covered all means for accompishing the result, and so was functional. We do not question the application of the rule as made to the facts of that case; but we do not understand that a claim is functional and invalid merely because one of its specified elements is 'means,' as in the Tyden Case, or 'mechanism,' as in the present case. This result may or may not follow, depending upon whether the all-inclusive term is used with reference to the element or subcombination which is the real point and gist of the invention, or whether it is used with reference to elements or parts of the combination already well known and designed only to co-operate with the new element in order to make a completely operative unit. In other words, where used with reference to the exact point of novelty, 'means' or 'mechanism' may expose the claim to attack on the ground that it is functional; in that respect, each case will present a problem by itself. *But where used with reference to the make-up of the field in which the real invention finds its usefulness or with reference to the connecting parts which permit the salient novelty of the invention to accomplish its function, these words are only a convenient formula of the broadest equivalency of which the real invention permits.*" (Italics ours.)

This same rule is substantially announced in the *Paper Bag* cases, *Faulkner v. Gibbs*, and many others, all of which

cases are not contrary to the *General Electric Co. v. Wabash Appliance Corp.* case and the *Halliburton Oil Well Cementing Co. v. Walker* case, but apply only where the "means" clauses are used with reference to the make-up of the field in which the real invention finds its usefulness or with reference to the connecting parts which permit the salient novelty of the invention to accomplish its function.

Can it be contended with any force that the salient novelty of the claimed invention here involved is not the provision of shifting means to shift the valve laterally into and out of the old eccentrically positioned valve socket or seat? Certainly, this is the ability which breathes life into the claims.

To permit this life-breathing ability to be described in the claims in terms of accomplishment or by a statement of function is to grant a monopoly over any and all means for achieving this ability, deprive the public of notice of the metes and bounds of the invention and stifle progress; all in direct contravention of the public interest which Congress recognized and sought to protect.

The construction of *35 U. S. Code Sec. 112* by the Court of Appeals for the Fifth Circuit in the present case is in direct conflict with an applicable decision of the Court of Appeals for the First Circuit in *S. D. Warren Co. v. Nashua Gummed & Coated Paper Co., 205 F. 2d 602*, wherein the Court said:

> "The functional claims doctrine stems from the statutory requirement of long standing that an applicant for a patent must particularly point out and distinctly

claim what he regards as his invention. See R. S. §4888, 35 U. S. C. §33, and now Title 35 U. S. C. §112. This requirement, the courts have repeatedly held, prevents a patentee from stating his invention in terms of the result he achieves instead of in terms of his method of achievement. But it does not forbid all statements of function, result or means in patent claims. *What it forbids is the description of the 'crucial element' of a claim in terms of accomplishment rather than in terms of physical characteristics; it forbids a statement of function or result at the precise point of novelty. See Halliburton Oil Well Cementing Co. v. Walker, supra.* The obvious purpose of the doctrine is to prevent a patentee from obtaining a monopoly over a wider area than he has pioneered." (Italics ours.)

Also, such decision of the Court of Appeals for the Fifth Circuit is in conflict with an applicable decision of the Court of Customs and Patent Appeals in *Application of Arbeit, 206 F. 2d 957*, where it is stated:

"The foregoing decisions, of course, were rendered before the Patent Act of 1952 was enacted. We think it is perfectly clear that under them and a long line of similar decisions, none of the appealed claims before us, except numbers 31 and 33, properly could have been allowed prior to the passage of that Act, and so, we come to the ultimate question of whether that Act has altered the patent law so that the purely functional limitations in claims 1, 37 (with its dependent claim 38), and 43 (with its dependent claims 44, 45, and 46), may be taken as meeting the statutory requirements of definiteness.

"The only changes in phraseology necessary to be considered in connection with that question are those found in the last paragraph of Sec. 112, supra. It seems obvious to us that a construction of that paragraph, such as appellant contends for, would render

it wholly inconsistent with the first and second paragraphs which, like former R. S. §4888, are explicit and *mandatory* in requiring a written description expressed in 'full, clear, concise and exact terms' *in the specification*, and so set forth *in the claims*. In the instant case, the descriptions given in appellants' specification are no more definite than the functional statements in the claims, and the latter are not sufficient to meet the requirements of the Act." (Emphasis is the Court's.)

We urge that the decision here involved erroneously construes and applies *35 U. S. Code Sec. 112*, in direct conflict with applicable decisions of other Courts of Appeal.

CONCLUSION

We respectfully urge that in the public interest and in the interest of uniformiity that this Court should review the Judgment here involved.

Respectfully submitted,

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May 26, 1958

CERTIFICATE OF SERVICE

Service of this Petition has been made upon Sid W. Richardson, Inc., by mailing a copy thereof by regular United States mail, with postage prepaid, to each of its attorneys, James C. Martin, Wilson Building, Corpus Christi, Texas, Herbert J. Brown, 701 Continental Life Building, Fort Worth, Texas, Ira Butler, 204 W. T. Waggoner Building, Fort Worth, Texas, Charles L. Stephens and Gillis Johnson, 1500 Sinclair Building, Fort Worth, Texas, this 26th day of May, 1958.

Attorney for Petitioner.

In the

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 16389

THOMAS E. BRYAN,

Appellant,

v.

SID W. RICHARDSON, INC.,

Appellee.

Appeal from the United States District Court for the Southern District of Texas.

(April 8, 1958.)

Before RIVES, BROWN and WISDOM, Circuit Judges.

BROWN, Circuit Judge: This appeal tests the correctness of the District Court's decree upholding validity of the dominant patent,[1] 162, and the continuation in part patent 903 and infringement on both by Bryan's device.

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[1] Howard et al 2,664,162, application June 24, 1948, patented December 29, 1953, issued to Kenneth C. Howard, Harold E. McGowen, Jr., and Howard H. Moore, Jr.

McGowen et al 2,679,903, issued to Harold E. McGowen, Jr. and Howard H. Moore, Jr., application November 23, 1949, patented June 1, 1954.

While Bryan's attack below took the full range of the typical infringer's defense, the case, after full trial and findings, comes to us considerably narrowed down.

The patents relate to the field of gas lift in the production of oil, the importance of which is attested by many such patents with which we have dealt.[2] In dealing, as most of them did, with the flow control valve itself, the emphasis has been on features which would assure continued regular performance of the valve under the high pressures and conditions encountered in view of the great cost in time and money as well as risk to the well itself when faulty valves have to be withdrawn and replaced. This was so because, up to the time of patent 162, there were but two principal types of control valve installations: (1) in a mandrel[3] by which the valve was positioned in an offset housing external to the tubing; or (2) in the axis of the tubing itself.

Each had a significant advantage but both had severe disadvantages and limitations. While in (1) it is obvious that the full internal diameter of the tubing was left open, the only way to remove the valve was to pull[4] the

[2]See e.g., Guiberson Corp. v. Garrett Oil Tools, Inc., 5 Cir., 205 F. 2d 660, footnote 3, p. 662; Bryan v. Garrett Oil Tools, Inc., 5 Cir., 245 F. 2d 365; Price-Trawick, Inc. v. Gas Lift Corp., 5 Cir., 101 F. 2d 134; and U. S. Industries, Inc. v. Otis Engineering Corporation (16528), 5 Cir., F. 2d

As these cases illustrate, gas is put into the annular space (the space between the well casing and the tubing through which the oil flows) under pressure; control valves are then installed, generally in series, which at predetermined pressures, permit the entry of gas from the annular space into the tubing either to lighten the column of oil by aeration or to lift a slug to the surface.

[3]A mandrel, as the term is generally applied, is any specially designed structure that is threaded, top and bottom, to be screwed into and form a part of the tubing. Its outside diameter is generally somewhat larger than that of the tubing.

[4]An expensive operation, estimated to run from $5,000 to $25,000 in cost, it was likewise accompanied by risk to the well. See footnote 3, Guiberson v. Garrett Oil Tools, note 2, supra.

tubing so that the valve housing mandrel could be removed from the string, opened up, and the valve removed and replaced. On the other hand, while in (2) the faulty valve located axially in the tubing could be removed by wire line tools without pulling the tubing, the very presence of the control valve blocked the tubing so that numerous operations[5] were prevented or could be done only by removal of all such valves. In addition, if control valves were installed in series, as they frequently are, one such valve could not be removed selectively. All valves above it had first to be removed.

The problem then was how to install valves which would be (a) removable selectively without pulling the tubing while (b) leaving the tubing open for operations.

Neither Bryan, the self-professed father of the gas lift art, armed with all of his patents and prior knowledge, nor anyone else had resolved it. It was, the District Court held on evidence which we deem overwhelming, solved by the patentees of 162. The patent discloses a combination which is non-patentese may be described generally. The mandrel was designed so that it was bulged out along one side. Within the mandrel this left a longitudinal area that was a continuation, without obstruction, of the tubing. In the internal space of the expanded portion provision was made for seating a conventional control valve so that, at a

[5]These included swabbing, paraffin cutting, bottom-hole pressure surveys, etc.

point *below* the seat, the port of the valve was exposed to the annulus. With the control valve in this position, the tubing was unobstructed and, at the same time, a portion of the valve (or its adaptor) was exposed within the mandrel for selective removal and replacement if necessary. This was to be accomplished by conventional and well-known devices, such as whipstocks and fishing tools, by which to effect the movement of the valve laterally to and from the axis of the tubing to the valve seat.

What had long been needed had now been found. What had been found, or its substantial equivalent, by commercial production beginning in 1952 became, and was, a great commercial success at the time Bryan introduced his device in 1954. Not surprisingly, what had long been unseen then became, retrospectively, perfectly obvious. And as a major stronghold in his system of fluid defenses below, Bryan took the usual tack that 162 was invalid as lacking in invention and novelty. Whether, under the specifications of error, the District Court's ruling adverse to him on this point is open to review as a technical matter, we need not determine. For Bryan, with a remarkable faculty for taking positions contrary to his own conduct which led the District Court to reject his testimony altogether,[6] in extravagant language of his own subsequent

[6]The District Court in its opinion stated:

"I hesitate to find that he (Bryan) deliberately falsified, but his testimony is of such a nature, so unsatisfactory, so many times in the face of the clear facts and his attempted purloining of plaintiff's invention so deliberate and brazen, that I find against him on all disputed issues."

patent application [7] in 1954 boasted that he had made precisely the same great discovery.

In this predicament Bryan's very able counsel now likewise champions the idea of novelty. But confining novelty to the manner in which the valve is moved laterally and is seated or unseated, he now levels the concentrated attack on the claims. Here again it is accompanied with that traditional flexibility seemingly inherent in the art of patent law in which, for validity the protest is that the claim is too broad, while for infringement it is to be narrowly and literally applied. That attack is here centered on the principal Claim[8] No. 1 on the ground that it is so

[7] Bryan filed application June 8, 1954, Serial No. 435117, for "Offset Valve Arrangement For Gas Lift System," patent not yet issued on date of trial but in which the Examiner had allowed claims 8 and 9. Bryan offered this to establish that the accused device, based on his patent application, was for a patentable improvement and hence not an infringement of 162 and 903. In that application he swore:

"Heretofore such injection valves have either been placed directly in the tube or have been attached to the side thereof in the most well known and widely used systems.

"Certain attempts have been made to provide offset pockets or chambers within the tubing for receiving these valves but up to the present time no satisfactory arrangement of this type has been known and a gas lift system with an offset chamber in the tubing for receiving the valve has thus not been determined to any degree of commercial acceptance."

[8] Claim 1 of Patent 162, letters in brackets ( ) are inserted and emphasis supplied to pinpoint Bryant's criticism:

"Claim 1 of '162

(a) In combination with a well tubing

(b) said tubing including one or more flow valve receiving sections

(c) each (section) having a portion laterally offset from the vertical main bore and provided with a flow valve seat in the offset portion,

(d) and *means*, including a shifting tool *adapted* to be lowered from the top of the tubing to the level of a selected section for selectively *seating* or *removing* a flow valve in or from its seat within a selected section.

(e) said shifting tool being provided with *means* for moving said tool and its appendages laterally within the offset portion of the selected section."

Claims 4 and 6 are also held valid and infringed. These append to Claim 1 as Claim 4 refers to well-known "jars" and Claim 6 states wherein the flow valve seat is formed in a flat base portion of each of the flow valve receiving sections."

broadly stated as to define the invention solely by statements of function and result. We do not agree.

The novelty was not, as Bryan claims, the mechanism by which the tool could be laterally shifted to insert or retrieve the valve. The novelty, as the Count found, was the "* * * combination of co-acting elements of a sidepocket mandrel and shifting tool which left open the tubing bore and yet had full selective retrievability of flow control units. Under prior-gas lift apparatus this had not been possible before." Bryan's contention that (a), (b), (c) of Claim 1, note 8, *supra*, are, or may be, old in the art, does not make the patent for a combination invalid. A combination whether composed of all old, or some old and some new elements, is patentable if it achieves an altogether new and useful result. *Cameron Iron Works v. Stekoll*, 5 Cir., 242 F. 2d 17; *Robertson Rock Bit Co. v. Hughes Tool Co.*, 5 Cir., 176 F. 2d 783. The life of such a combination is not to be destroyed by excision of its several parts without benefit of anaethesia, nor is the cause of its vitality to be discovered by the prosector's retrospective dissection. *Jeoffroy Mfg. v. Graham*, 5 Cir., 206 F. 2d 772, 776.

Nor does that cause the *means* portion of (d) and (e) of Claim 1, note 8, *supra*, to infect the whole new combination with a virus of invalidity. *E-I-M Co. v. Philadelphia Gear Works, Inc.*, 5 Cir., 205 F. 2d 28, 29. The Court, on ample evidence, found that (d) and (e), relating to the movable elements, referred to well-known devices such as kickovers, centralizers, whipstocks or slanted guides and other tools or devices, such as wire lines, knuckle joints, jars, thread-

ing and latching for selectively seating or removing the valve.

The word "means" is no shibboleth. To be sure, it, or its equivalent synonyms, cannot be used to describe the invention at the very point of novely for to do so would then be to define invention in terms of the result. But where the novelty of the combination—here the "stationary element or receiving section consisting of a side-pocket mandrel as an integral part of the tubing string * * * capable of selectively receiving, seating and disgorging a flow control unit * * * lowered from the surface * * *" is adequately disclosed with definable limitations, other and well-known elements need not be described in structural detail. Section 112 of the Patent Act of 1952, 35 USCA 112, expressly[9] permits it. If *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, 91 L. ed. 3, caused either a real or psychosomatic[10] infirmity in the body of the prior law, it is plain that Section 112 was meant as a sufficient transfusion to restore vitality to the principles before and since pronounced.[11]

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[9]"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

[10]Cf. Moist Cold Refg. Co. v. Lou Johnson Co., 9 Cir., 217 F. 2d 39, 42; see also Application of Lundberg, CCPA, 244 F. 2d 543, 547.

[11]Faulkner v. Gibbs, 338 U. S. 267, 94 L. ed. 62; General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364, 82 L. ed. 1402; Davis Sewing Machine Co. v. New Departure Mfg. Co., 6 Cir., 217 Fed. 775; see Commentary Examiner in Chief, U. S. Patent Office, in the Introduction to Title 35 of U. S. C. A. p. 25; Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 52 L. ed. 1123; E-I-M Co. v. Philadelphia Gear Works, 5 Cir., 205 F. 2d 28; Robertson Rock Bit Co. v. Hughes Tool Co., 5 Cir., 176 F. 2d 783; Technical Tape Corp. v. Minnesota Mining & Mfg. Co., 2 Cir., 247 F. 2d 343; Georgia Kaolin Co. v. Thiele Kaolin Co., 5 Cir., 228 F. 2d 267; Ellis on Patent Claims (1949), Sections 263, 264, pages 346-8.

When the claim with this language in it is construed in the light of the disclosures of the patent, it does not grant a monopoly on every means or mode by which that result could be achieved. As the Act phrases it, these are confined to *corresponding structures* or *acts described* in the specification and equivalents thereof. Our discussion of infringement will demonstrate that the Court's findings of equivaleney on these elements is likewise supported.

The Court's holding of validity of 162 was adequately supported by facts and was correct. *Bryan v. Garrett Oil Tools, Inc.*, 5 Cir., 245 F. 2d 365, 371; *Georgia Kaolin Co. v. Thiele Kaolin Co.*, 5 Cir., 228 F. 2d 267; *Jeoffroy Mfg. Inc. v. Graham*, 5 Cir., 206 F. 2d 772.

Validity of 903

For the reasons discussed concerning 162, the claims in suit[12] of continuation patent 903 satisfy the requirements of invention and novelty. Like the dominant patent 162, it

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[12]Only Claims 1, 2, 3, 4 are involved here. The remaining claims are directed to the combination of the valve housing and a described form of shifting tool.

"1. Well tubing comprising a flow control unit receiving section having an enlarged intermediate portion of greater internal cross sectional area than the internal cross sectional area of the ends thereof, a laterally offset internal elongated tubular portion formed in the enlarged intermediate portion having upper and lower portions provided with aligned openings forming seats for said unit."

Claim 2 adds words describing "an external recess forced in the enlarged intermediate portion, said recess having upper and lower wall portions provided with aligned * * * openings." Claim 3 adds "guide means for the flow control unit comprising an internal ring located within the enlarged interior of the special section having its opening in alignment with the opening in the transverse wall portion." Claim 4 specifies "an external recess," "upper and lower wall portions," and "an internal ring within the enlarged portion having an opening above and in alignment with the aforesaid openings to provide means for guiding the flow control unit into the upper and lower wall openings."

comes here with the presumption of validity. 35 USCA 282; *Jeoffroy Mfg., Inc. v. Graham*, 5 Cir., 219 F. 2d 511, 519.

In 903 the flow valve receiving section of the mandrel was designed to take advantage of the known principle of balanced pressures. In the drawings of 903 and the disclosure, there was an external recess in the wide part of the mandrel. Above and below the recess there was a circular opening through which the valve was inserted and thus sealed. When installed, the bottom end of the valve with its port opening into the tubing was inside the mandrel below the recess, and the top portion of the valve was inside the mandrel above the upper recess. The port of the valve for admission of gas from the annulus was exposed in this recess. This was a useful improvement as a sub-combination in the combination, the novelty and usefulness of which involved the employment of double seats above and below the point where the mandrel opened onto the annulus.

But, Bryan says, that since it is his contention that the accused device does not include the external recess of Claim 2 or the guide means in Claim 3 and the internal ring in Claim 4, so that infringement, later discussed, can result only by equivalence, then all four claims are a substantial restatement of Claim 1 and as such are anticipated by prior patents,[13] Kyner 247, Bryan 345, and 648 and Garrett 107.

[13] Kyner 2,210,247; the flow control valve is manually placed in an external housing and can be removed only by pulling the tubing to the surface.

Bryan 2,275,345; removable gas lift valve, the valve located in the axis of the tubing.

Garrett 2,230,107; insertable and removable valve located in the axis of the tubing.

Bryan 2,255,648; gas lift apparatus located in the axis of the tubing. See Bryan v. Garrett Oil Tools, Inc., 5 Cir., 245 F. 2d 365.

This argument rests on the premise that the claim is to be read apart from the disclosures of the patent so that literally the flow control unit receiving section decribed could be situated outside of the tubing or the axis of the tubing with no requirement that it be possible to insert or remove valves without pulling the tubing or clearing the axis of the tubing. But of course the claims are to be read in the light of other claims. *W. D. Haden Co. v. Mathieson Alkali Works, Inc.*, 5 Cir., 122 F. 2d 650, 651, and, as the Court below pointed out, "Claims 3 and 4 * * * call for 'guide means' and 'means for guiding the flow-control unit' which would be wholly unnecessary for manual insertion at the surface," and, in addition "the last five claims * * * exhibit that they are for tools for underground use with the stationary element * * *." The patent, by claims and specifications, disclosed that it, as a continuation in part of the dominant patent, was to achieve the novel function of selectively seating or retrieving control valves without pulling tubing or blocking the tubing axis.

Infringement of 162 and 903

At the outset, we affirm as clearly supported both the implication and the express holding that Bryan's device is traceable in fact directly to these patents. Despite his long experience in this field, both by deed and word, he affirmed the utility of the dominant patent by the fact that not until 1954, two years after the first commercial version of the patent was put on the market with considerable success, did he ever design or onstruct the accused de-

vice. He had, in the meantime, also obtained in 1952 shop drawings in connection with the settlement of a license dispute. Indeed, it goes even farther back for in 1948 he received, although he later made a denial which the Court discredited, see note 6, *supra*, original drawings from McGowen. This was followed by several conferences with McGowen at Bryan's shop in Fort Worth where, at first, he encouraged these young men to work out an arrangement with him, although later, by a change of tune, he began to suggest that their device was of little value if it were not an infringement of some of his own existing patents.

There was nothing to suggest, indeed much contradicted it, that Bryan at any of these times had conducted any research or experiments which led him to this discovery. He got by taking, not inventing. *Matthews v. Koolvent Metal Awning Co.*, 5 Cir., 158 F. 2d 37, 39; *Robertson Rock Bit Co. v. Hughes Tool Co.*, 5 Cir., 176 F. 2d 783, 786.

If there is no infringement, it is because the effort to copy and imitate has been so cleverly done that the device does not operate in substantially the same way as either or both of the patented combinations or sub-combinations.

The District Judge, familiar as he was with oil and gas operations and its long-time importance to the economy of Texas, described this device as one which "fulfilled more than a long-felt need in the industry, something new and useful, which might be said, without overstatement, almost to be revolutionary * * *." Because of its great utility, it "was meritorious and a further important step

forward in the art," *Southern Saw Service, Inc. v. Pittsburgh-Erie Saw Corp.*, 5 Cir., 239 F. 2d 339, 345, and as such was entitled to a reasonable and liberal interpretation in the light of the full disclosure and to a reasonable range of equivalents.

A comparative analysis, claim by claim, element by element, matching patent against device, helpful both to trial and appellate court, *Bryan v. Garrett Oil Tools, Inc.*, 5 Cir., 245 F. 2d 365, reveals here that these claims of 162 read literally on the accused device. The accused device has a side-pocket mandrel with provisions for a valve seat in the offset portion permitting the seating and removal of valves by tools which deflect laterally and can be operated from the surface.

It does not matter that this is accomplished in Bryan's device by operations or structures which are somewhat different in form. For what is done is done substantially in the same way, by substantially identical means, by substantally the same mode of operation to produce the admittedly identical result. That the specifications and drawings in 162 (and the claims 2 and 3 not here in suit) describe apparatus by which the valve is seated or unseated by being screwed into the flow valve receiving portion of the mandrel either by an electrical reversible motor or mechanically by a ratchet drive is not decisive. Protection of the patent is not "limited to the preferred embodiments shown in the drawings," *Cameron Iron Works v. Stekoll*, 5 Cir., 242 F. 2d 17, 20; *Jeoffroy Mfg., Inc. v. Graham*, 5 Cir., 219 F. 2d 511, 514. The seating and sealing of a valve

by screw threads is the mere mechanical equivalent of other means such as O-rings and latches, *Bryan v. Garrett Oil Tools, Inc.*, 5 Cir., 245 F. 2d 365, 368.

The same is true of the means used in Bryan's device to deflect the tool laterally. He uses a slanted guide near the upper collar of the mandrel with compressible fingers which, depending on the length of the tool with its adapter permits it to move laterally into the expanded portion of the mandrel or continue down through the tubing to the location of the valve to be selected. In 162 a bow or leaf spring which is actuated by a simple trigger accomplishes the same thing. Both are variants of the ancient learning of whipstocks. While it is true that in 162 the valve is seated so that the main body of the valve protrudes out into the annulus through the expanded portion of the mandrel, the accused device must, of course, accomplish the same thing by exposing a valve port to the annulus. The same result is achieved by substantially similar means for in both the valve is seated and sealed *above* the port exposed to the annulus and the record affirms that holes drilled in the side of the mandrel (either in Bryan's or the commercial version of 903) is the equivalent of a recess. The valve is thus exposed in fact to the annulus. If it be assumed *arguendo* (we neither decide nor intimate decision) that the accused device was a patentable improvement over 162 on this score, that would not excuse infringement of the dominant patent. *Hunt Tool Co. v. Lawrence*, 5 Cir., 242 F. 2d 347, 352. *Matthews v. Koolvent Metal Awning Co.*, 5 Cir., 158 F. 2d 37, 40; *Zachos v. Sher-*

win-Williams Co., 5 Cir., 164 F. 2d 234; *Temco v. Apco*, 275 U. S. 319, 338, 72 L. ed. 298, 302.

The obvious imitation of 903 is even more startling than in the case of 162 once it is recognized, as the evidence here overwhelmingly commands, that the external recess described in the specifications and drawings and referred to in several of the claims, is the equivalent, or vice versa, of several holes drilled in the side of the mandrel as in Bryan's device and the commercial version of 903. There is first the expanded portion of the mandrel with an internal elongated tubular portion formed in the expanded section of it. There is an upper and lower portion either above the external recess in the form shown on the drawings or its equivalent by ports in the mandrel. And this is provided with aligned openings forming seats for the control valve. On the drawings these are shown as the guide ring and the two aligned openings with valve seats. The tubular socket with its tapered top of Bryan's device is again the mere equivalent of this. There is an opening by holes through the mandrel to the annulus and in the tubular socket there are two internal rings, one above, one below, the ports to the annulus and against which Bryan's O-rings effect two seats in the upper and lower wall portions. In the catalogue Bryan offered Chevron rings as a substitute for O-rings as the customer preferred. Both were "ring seals."

The Court had more than an ample basis for concluding in fact that Bryan took not only the idea but the means of accomplishment, and that his skill was directed toward

contriving a mechanism which appeared to be, but was not in fact, different than 162 or 903. There it ends. *Georgia Kaolin Co. v. Thiele Kaolin Co.*, 5 Cir., 228 F. 2d 267; *Fritz W. Glitsch & Sons, Inc. v. Wyatt Metal & Boiler Works*, 5 Cir., 224 F. 2d 331; *Jeoffroy Mfg., Inc. v. Graham*, 5 Cir., 206 F. 2d 772.

Bryan's Defensive Counterclaim

Each defense having thus successively collapsed, Bryan retreats now to the last, but favorite isle of resistance, to claim that while found to be a poacher he may nonetheless keep his game because the patent owner has been guilty of monopolistic abuses. This was certainly a fact issue and the Court by findings not clearly erroneous resolved it against him. In the main it was nothing more than the lament that the patentee had given written (and oral) notices to several oil companies, as prospective users of Bryan's device, that the machine infringed on these patents. A patentee has that right, *Robertson Rock Bit Co. v. Hughes Tool Co.*, 5 Cir., 176 F. 2d 783, 785; *Gillman v. Stern*, 2 Cir., 114 F. 2d 28, 32. Indeed, his ability to recover indemnity may date from it, 35 USCA 287, *Livesay Window Company, Inc. v. Livesay Industries, Inc.*, 5 Cir., F. 2d [No. 16403]. Moreover, this is a reasonable thing for businessmen to do since it is hardly to be thought that it is a sign of *bad faith* to warn friendly customers, present or potential, that if they purchase a competing infringing tool, litigation against them might be necessary. Nor does the failure to sue the users thus warned give it a bad brand.

If the patent exists, and is valid, as we have held, the warning is a legitimate sanction. A patent is to protect the patentee in his monopoly against the depredations of others. He may sue, but he need not, and if he sues, he may take after a user or the manufacturer or both. The infringing manufacturer cannot complain that the gage lay at his feet.

AFFIRMED.

A true copy
Test: EDWARD W. WADSWORTH
Clerk, U. S. Court of Appeals, Fifth Circuit
By /s/ CLARA R. JAMES
Deputy
New Orleans, Louisiana

JUDGMENT.

Extract from the Minutes of April 8, 1958

No. 16389

THOMAS E. BRYAN,

v.

SID W. RICHARDSON, INC.,

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Texas, and was argued by counsel;

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed;

It is further ordered and adjudged that the appellant, Thomas E. Bryan, and the surety on the appeal bond herein, Travelers Indemnity Company, be condemned, in solido, to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1957

No. ~~1029~~ 70

THOMAS E. BRYAN,
Petitioner,

vs.

SID W. RICHARDSON, INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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June 25, 1958

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IN THE

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Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

RESPONDENT'S BRIEF IN OPPOSITION

Opinions Below

The opinion of the District Court (R. 835-46) is reported at 114 F. Supp. 916. The opinion of the United States Court of Appeals for the 5th Circuit is reported at 254 F. 2d 191.

Jurisdiction

The jurisdictional requisites are adequately set forth in the petition.

Questions Presented

Question 1: Is it necessary in this case to even resort to the third paragraph of Section 112 of the Patent Act as added in 1952, or to try to construe such amendment in the light of the case law govern-

ing claims in combination patents both before and since such amendment which have often sustained the validity of a combination patent in which it appeared that novelty lay in the combination itself, although "means" language had been employed concerning one of the old elements in such novel combination?

This question should be answered in the *negative* under *Faulkner v. Gibbs* and other cases.

Question 2: In a combination patent, the validity of which has been sustained by both courts below because of novelty residing in the combination itself, as well as novelty of one of the elements in such combination (to wit, the stationary element), is it permissible under Section 112 of the Patent Act as amended in 1952 to employ "means" language with reference to the performance of a specified function in the novel combination of an old and well understood device (to wit, the movable element), with which the novel element is designed to co-act and cooperate to make a new and complete working **machine**, producing a new and useful result never before possible?

This question should be answered in the *affirmative* under the plain language added in 1952.

Question 3: When, on the basis of disputed testimony of patent experts and after lengthy demonstrations, the lower courts have found the precise point of novelty of a combination patent to reside in the *combination* itself, which incorporates a *new* sta-

[1] 28th Finding of Fact, R. 862.

tionary element, which in co-action with *old* and well known movable devices makes a complete operating machine, will this Court undertake to review the factual findings of both courts below in the complete absence of "a very obvious and exceptional showing of error," and especially in this case in which the petitioner has failed both here and in each of the lower courts to anywhere directly challenge the findings of fact made against him as being without support in the evidence, and has further failed to demonstrate that the courts below have clearly misapprehended the effect of the evidence?

The answer to this question should be in the *negative*, and petitioner's effort to now confine and fasten our claimed novelty to the old movable element must be rejected.

Statutes Involved

The pertinent provisions of the Patent Act of 1952, 35 U. S. Code, Section 112, are set forth in the petition at p. 4.

Statement

1. *Nature of the case:*

This is an ordinary patent suit brought by respondent against petitioner for infringement of Claims 1, 4 and 6 of its combination Patent 162 and Claims 1 through 4 of its improvement Patent 903. The trial court, after a full hearing and based upon conflicting testimony of expert witnesses and demonstrations, and

[2]District Court's opinion, 144 F. Supp. at 920, par. 4.

based upon comprehensive findings of fact and conclusions of law (R. 846-75), held the patents valid and petitioner's infringement willful and deliberate[3] and entered a judgment (R. 875-8) permanently enjoining petitioner from making, using or selling his accused device and any other apparatus embodying the invention protected by the claims in issue of the two patents. This judgment was affirmed on appeal by the 5th Circuit.

Since no other suit has been brought for infringement of these patents, this case presents no conflict of decisions between courts of appeals with respect thereto. The decision below, of which petitioner asks review in part only, is based upon its own facts and affects no one but the litigants. The petition only seeks review of that portion of the judgment validating respondent's combination Patent 162 (petition, p. 5), and even its attack on that patent is now limited to the charge of employing "means" language with respect to an old and well-known element in claimed contravention of what is urged as being the "doctrine" announced by this Court in *Wabash*[4] and *Halliburton*[5].

Such attack is based on a pretense diametrically opposed to findings of both courts below, arrived

[3] 144 F. Supp. 918, as to which he stated in footnote 4 at that juncture of his opinion: "I hesitate to find that he (petitioner) deliberately falsified, but his testimony is of such a nature, so unsatisfactory, so many times in the face of the clear facts and his attempted purloining of plaintiff's invention so deliberate and brazen, that I find against him on all disputed issues," and of which the 5th Circuit took note in its opinion (254 F 2d 193, fn. 6).

[4] *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364.

[5] *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1

at after studied consideration of the disputed testimony on the point resolving against petitioner his express contention there made that the novelty of the invention covered by Claims 1, 4 and 6 of 162 lay only in the new use of old and well-known devices to be employed for laterally shifting a gas-lift valve into the side-pocket seat, located hundreds of thousands of feet below the surface of the ground, while suspended from the end of a wire line (petition, p. 7). This attack involves questions of fact twice resolved against petitioner by the courts below and should not be further reviewed by this Court.

2. *Counter-Statement of the facts:*

Petitioner's "Concise Statement of the Case" is argumentative and ignores express findings of fact to the contrary at no point in this litigation challenged by petitioner, and his statement is further incomplete and gives an inaccurate impression of the facts and of the only issue that can now be involved here. A clearer and more accurate statement of the case follows:

The District Court, After Hearing Conflicting Testimony on the Issue of Novelty and With Respect to Just Wherein the Novelty of Combination Patent 162 Lay, Made Findings of Fact Which Settled the Issue

Respondent's combination Patent 162 here involved relates to the production of oil by the gas-lift method.* It did not deal with a gas flow-control valve itself,

*Described in footnote 2 of the 5th Circuit's opinion, 254 F. 2d at 192.

but instead disclosed to the oil and gas industry for the first time[7] a receptacle or "mandrel" permitting as employed in such novel combination selective insertion and removal of such a valve or valves underground while at the same time leaving the tubing bore fully open so as to permit numerous desirable well operations below the point of such installation or installations. (Usually a number of such valves will be installed in series in the system.)

The claims in issue of combination Patent 162 constituted invention of "pioneer or near-pioneer status," "fulfilled a pressing need in the industry never before solved by common ingenuity and which had eluded the search of all others skilled in the art, including defendant," and were accordingly found to be entitled to "liberal interpretation and broad equivalents consistent with the scope of the novel concept and the importance of the contribution to the industry."[8]

The long existing problem[9] was solved by respondent's 162 disclosing "the *novel concept of a combination* of co-acting elements of a side-pocket mandrel and shifting tool which left open the tubing bore and yet had full selective retrievability of flow-control units. Under prior gas-lift apparatus this had not been possible before."[10]

In order to further show that the questions said by the petition (p. 3) to be here presented have been

[7]Conceded by Bryan on cross-examination (R. 521) and so found by the trial court (Memorandum Opinion, R. 835; Finding of Fact No. 10, R. 850-51.

[8]16th Finding, R. 853-54.

[9]12th Finding, R 852.

[10]10th Finding, R. 851.

finally settled below on the facts, we quote at length from the trial court's 19th Finding (R. 855-56), which is a complete answer to petitioner's contention as to where the **precise point of novelty** lay in combination Patent 162:

> "19. The new element in the novel combination was the stationary element or receiving section consisting of a side-pocket mandrel as an integral part of the tubing string . . . while the suspended movable element and parts for lateral shifting by well-known kick-overs, centralizers, whipstocks, trap doors, and by other slanted guides was in fact old in the oil well art and in the industry and only put to a new use in the novel combination . . . and *the precise point of novelty in the invention did* **not** *reside in the movable element and its parts.*"

Petitioner still argues otherwise, although all findings of the trial court stand unchallenged here.

With respect to the detail in the specifications and claims required by Section 112, the trial court further found [11] that the patent applicants had described the essence of the invention in permissible language and had given different illustrative forms of the old element — the kick-over tool, as to which petitioner seeks to limit novelty — and had:

> ". . . disclosed to anyone skilled in the art that the novel combination was fully operative and would permit the inventive co-action claimed while underground between the *novel offset mandrel* as the stationary element and many forms of the old and well known tools and sub-combina-

[11] 20th Finding, R. 856-58.

tions capable of being suspended and laterally deflected in a well . . . ."

and that:

"The 'means' language employed in Claim 1 of patent 162 with respect to the old element was only a convenient formula of the broadest equivalency of which the real invention permitted and extended as broadly as was consistent with the extent of the inventive step . . . ."

and that:

". . . the 'means' language as structurally limited to the shifting tool capable of lateral deflection with its appendages which had been taken from the prior art was not subject to the charge that it was a purely functional statement which went beyond the point of invention, and anyone skilled in the art reading such combination claims in the light of the complete disclosure could have construed such a combination and readily apprehended the nature of the invention and the limits of its scope."

Respondent's Patent 903 (R. 1039) — the validity and petitioner's infringement of which are no longer contested by him — was granted upon an application filed as an express continuation in part of respondent's 162 as constituting an improvement of elements or subcombinations of dominant 162. While the claims in 162 were on the novel combination, the claims of 903 were either on the stationary element or mandrel per se (Claims 1 through 4, as to which respondent charged infringement by petitioner) or on a mechanical version of a kick-over tool per se thereafter in-

vented (as to which respondent did not charge infringement because not of the opinion that the kick-over apparatus in the accused device fell within their scope).

Likewise, respondent's improvement Patent 904 (R. 1225) was granted upon an application filed as a continuation in part of dominant 162. It pertained only to an improved electrical type of kick-over device. (It was not sued upon by respondent, but by counterclaim petitioner sought to put it at issue; his counterclaim was dismissed by paragraph 10 of the trial court's judgment, R. 874).

It is thus not true, as stated in the petition at p. 6, that upon a single simple improvement over the prior art respondent was "issued five different sets of patent claims in three patents." 903 is no longer involved in this litigation, and 904 never fairly was; reference to them in the petition only beclouds the issue.

In final rebuttal to petitioner's "Concise Statement of the Case" we quote the trial court's 22nd Finding of fact (R. 858), arrived at only after his careful consideration of the disputed testimony with respect to the state of the art existing at the time of 162's invention and his determination of what was novel and entitled to be claimed in said patent:

> "22. The claims in issue in Patent 162, when fairly read and interpreted, do not overclaim or seek to cover a mere idea or result and are not subject to the vice of employing functional language at the sole point of novelty. The claims and specifications of Patent 162 comply with the requirements of Section 112."

although we could, at the expense of lengthening this reply, quote many other findings of the trial court with respect to the prior art showing that the problem existing at the time of 162's invention was not as simple as petitioner infers in his statement of the case, and that instead its disclosure constituted a great step forward in the art.

* * *

Argument

In an effort to secure certiorari, petitioner misinterprets the holdings below and, ignoring the novelty of our stationary element, here asserts that they are in conflict with the interpretation placed by this court in *Wabash* and *Halliburton* upon the predecessor to present Section 112 of the 1952 Patent Act. The "conflict" which petitioner seeks to create is without substance. This court's holding in *Faulkner v.Gibbs**,338 U. S. 267, is a complete answer to the entire petition and requires its denial, because here, as there, the patent is also sustainable "because of the fact of combination rather than the novelty of any particular element." (*Id.* 338 U.S. 268).

This is borne out by express statement in the opinion you are asked to review:

> "The novelty, as the (trial) Court found, was the '***combination of co-acting elements . . ." 254 F.2d 194, par. 2.

Contrary to fact, the petition infers (p. 20) that the courts below sustained the validity of 162 only on the basis that its claims were saved "by virtue" of the third paragraph of Section 112, and further only because the courts below entertained the opinion that the third paragraph of Section 112, added to the previous two paragraphs contained in its predecessor, "modified or dominated" such two earlier paragraphs "to an extent that it now overrules the line of cases headed by the *General Electric Co. v. Wabash Appliance*

*In which this court, "being moved by the petition . . . that there was a conflict with *Halliburton* . . . granted certiorari" but then held Halliburton "inapposite."

Corp. case and the *Halliburton Oil Well Cementing* which formerly violated that statute."

Petitioner's inference is unwarranted, however, because it is clear from the opinions of both courts below that their judgments were not based solely upon §112 but were instead also grounded upon the long line of cases beginning with *Paper Bag*[12] and culminating with this court's latest pronouncement on the point in *Faulkner v. Gibbs.*

The trial court stated in his opinion:

> "Usage of what otherwise might seem to be functional language in combination patents had been recognized as proper in many cases (citing in a footnote Paper Bag, Faulkner v. Gibbs, Davis Sewing Machine Co. v. New Departure and other cases) before the amendment of 1952 . . . . the Court, before the amendment, again recognized in Faulkner v. Gibbs . . . propriety of the use of functional language in combination patents and patentability 'because of the fact of combination rather than the novelty of any particular element . . . .' To my mind there is no conflict between Halliburton and Faulkner v. Gibbs as to the *principles* announced." Id., 144 F. Supp. 920-921 (emphasis by the court).

The Fifth Circuit opinion considered that §112 "was meant . . . to restore vitality to the principles *before* and since pronounced (citing Faulkner v. Gibbs, Davis Sewing Machine, Paper Bag among other authorities)." *Id.*, 254 F. 2d 194, par. 3.

---

[12]*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405.

I

The Decision Below is Clearly Correct

In his attack upon 162 it is petitioner's strategem to avoid its complete disclosure and, although there was incorporated in such combination as a new element the stationary side-pocket mandrel, to pretend that the novelty and invention lay in the movable element. But the findings of fact made below, unchallenged here, contradict him, as already pointed out in our counter-statement. Even if such findings were here challenged and reviewed by this court it would be found that they have "ample" support in the evidence:

> "Q. ***what in your opinion is the exact point of novelty in the 162 Combination Patent?
>
> "A. *The novelty is in the combination.* It is a combination of elements and some new and some old that produce new and improved results." (Lane, R. 794).

In an attempt to show that the claims "are fatally indefinite and functional" the petition (p. 10-11) seeks to segregate the elements thereof with counsel's "commentary" arguing that none of the elements so segregated show novelty and that only the "use of a shifting tool . . . breathes life into the claim and consequently therein is the exact point of novelty . . . (and that) to argue otherwise appears without basis."

It is not a matter of "*arguing*" otherwise but instead of whether the trial court's *factual* finding otherwise[13] is correct—a matter not subject to review here under the questions assigned by the petition.

[13]". . . the precise point of novelty did *not* reside in the movable element and its parts." (19th Finding, R. 855).

Claims in 162 are Valid Even Without the Aid of the new Language in Section 112

Long prior to the 1952 statutory amendment expressly authorizing the employment of "means" language, and at least since the decision in "Paper Bag" which has never been overruled[14], the employment of means language in a combination claim was permitted. Such is also the essential current holding by the Supreme Court in *Faulkner v. Gibbs*, 338 U. S. 267, where this court sustained a combination patent as against the attack that it "merely represented an attempt to patent a function or result"[15] "because of the fact of combination rather than the novelty of any particular element."[16]

In conceding (petition, p. 22) that such cases permit the use of "means" language where used "with reference to the connecting parts which permit the salient novelty of the invention to accomplish its function," petitioner effectually admits himself out of court, because, as found by the courts below, that was the very use to which the "means" language was put in 162. As pointed out in quoted language from the opinion in the *Davis Sewing Machine* case, which appears at p. 21 of the petition, a claim is not functional and invalid "merely because one of its specified elements is 'means,' " and it is permissible to use means language "with reference to elements or parts of the combination *already well known* and designed only to co-operate

[14] But instead was explained with approval by this court in Halliburton: "In that case, however, the claims structurally described the physical and operating relationship of all the crucial parts of the novel combination." 329 U.S. @ 13-14.

[15] See appellate opinion, 170 F. 2d 34, 35.

[16] Id., 338 U.S. @ 268.

with the new element in order to make a completely operative unit."

What better description could fit the employment of the "means" language here? As we have already seen, the trial court expressly found that not only was the combination novel but also that its stationary element was novel, and further that the kick-over or deflecting devices called for in "means" language were already old in the art and only put to a new use in the combination patent to cooperate with the new mandrel "to make a completely operative unit."

In almost the same language employed in the *Davis Sewing Machine* case, the trial court in his opinion found that the "means" language employed in 162 was:

> ". . . used twice in Claim 1 in connection with with movable elements or parts already well known and designed to co-operate with the new element in order to make a complete operating machine."[17]

Even if one accepts, arguendo, petitioner's contention that Section 112 merely codified "the previous case law" and that "the rule is best stated in Davis Sewing Machine Company" (petition, p. 21), it is readily apparent that the employment of means language in such Claim 1 of 162 complied with the rule stated in that case. When it is realized that the true point of novelty as factually ascertained by the trial court resided in the combination of the novel stationary element, designed to cooperate with old and well-known kick-over devices to make a complete operating machine, it be-

[17]44 F. Supp. 920, par. 4.

comes clear that the claim was properly and validly drawn under the rule of the *Davis Sewing Machine*, *Paper Bag*, and *Faulkner v. Gibbs* cases.

Before one can reach for determination petitioner's contention that the *Wabash* and *Halliburton* doctrines control, there must first be overturned this finding of the trial court with respect to where the novelty lay in 162, and this the court cannot do because not only is there complete absence "of a very obvious and exceptional showing of error" with respect to such finding, but also because petitioner has not even challenged it.

As this Court succinctly stated in its first *Graver Tank* opinion (331 U.S. 271 at 275):

> "A court of law, such as this Court is, rather than a court for correction of errors in fact-finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error . . ."

It is therefore obvious that for this Court to review the judgments below upholding the validity of 162 would of necessity require a redetermination of a factual issue through examination, contrary to the rule oftentimes announced by this court,[18] of an extensive record resulting from a week-long trial containing disputed testimony of patent experts on the point twice resolved in respondent's favor by the courts below.

[18] *Williams Mfg. v. United Shoe Machinery Co.*, 316 U.S. 364; the Second *Graver Tank* case, 336 U.S. 271; and *Faulkner v. Gibbs*, 338 U.S. 267.

II

There is No Conflict of Decision

Petitioner seeks to invoke your jurisdiction upon a claimed conflict between the decision below and "applicable decisions of this Court and Courts of Appeals of other Circuits"[19] and further because it is said that the Fifth Circuit "has erroneously construed and applied" 35 U.S.C. §112.

This is the only time that respondent's 162 patent has been before a court for adjudication, and so there can exist no conflict between the decision below and any other with respect to it. We shall demonstrate that such decision below is not in conflict in principle with this court's decision in *Wabash* or *Halliburton*, but instead in harmony with their pronouncements, and that the same is true of the decision in *Warren v. Nashua*:

1. *General Electric v. Wabash*, 304 U.S. 364.

In this case the claims were invalidated because the inventor "did not adequately set out 'what he claims to be new' " in the very limited field in which he was working (304 U.S. @ 369). The crowded art upon which the inventor had sought to improve involved incandescent lamps, and the problem he sought to solve was the prevention from sagging of the tungsten filament in such lamps. He sought to accomplish this by bringing into intimate association with the tungsten during its heat process of being made into a filament an alkaline silicate which would control the grain

[19]He only cites one opinion by the First Circuit: *Warren v. Nashua*, 205 F. 2d 602.

growth of the tungsten. In speaking on the definiteness required in a patent pertaining to such a crowded art, this court there said:

> "Patentees may reasonably anticipate that claimed inventions, improvements and discoveries, turning on points so refined as the granular structure of products require precise descriptions of the new characteristic for which protection is sought. In a limited field the variant must be clearly defined. This was one in a series of patents." *Id.*, 304 U.S. 369.

But instead of giving such a clear definition of his new variant in his method patent, the inventor instead merely defined it in terms of the solution of the problem (e.g., a "frost-less refrigerator coil," "perpetual motion", etc.). His claim 25, regarded as typical, read in part:

> "25. A filament . . . composed substantially of tungsten and made up mainly of a number of comparatively large grains *of such size and contour as to prevent substantial sagging . . .*"

His only novelty was thus expressed, in the language italicized, in terms of result, of which clause this court there said:

> "The clause is inadequate as a description of the structurel characteristics of the grains." *Id.* p. 370.

and that the claim thus fell

> "within the condemnation of the doctrine that a patentee may not broaden his product claims

by describing the product in terms of function." *Id.* p. 371.

But this court did not there condemn all use of "functional" or "means" language; it only did so with respect to use of same "at the exact point of novelty (*Id.*, p. 371), saying:

> "A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent." *Id.*, p. 371-72.

As we have seen, the trial court expressly found that the means language in respondent's 162 patent was not employed at the precise point of novelty but was instead used only

> ". . . with respect to the old element . . . and anyone skilled in the art reading such combination claims in the light of the complete disclosure could have constructed such a combination and readily apprehended the nature of the invention and the limits of its scope." (20th Finding, R. 857-58).

There could only be conflict between the decision below and the holding in *Wabash* if petitioner's postulate with respect to where the novelty in 162 lay were correct; as the trial court found against him on this factual issue, and such finding is not challenged here, the *Wabash* rule is inapposite.

2. *Halliburton v. Walker*, 329 U.S. 1.

An examination of the history of the litigation in Halliburton clearly discloses that its holding is also "inapposite" to the combination patent here involved, just as it was held inapposite to the combination patent involved in *Faulkner v. Gibbs*, 338 U.S. 267. Further distinguishing our case is the fact that one of the elements in 162 was itself *new*.

The trial court had found that Halliburton was infringing Claims 1, 13, 14, 15 and 17 of Walker's 519 Patent[20]. In its opinion this Honorable Court expressly recognized that other claims of that patent (not claimed to be infringed), e.g., Claims 2 and 3, did sufficiently describe the old element Walker had added to an old combination as to show "its working arrangement in the alleged new combination, and the manner of its connection with the other parts"[21], but this Court there reversed the holdings below because;

> "No one of the claims on which this judgment rests has even suggested the physical structure of the acoustical resonator. No one of these claims describes the physical relation of the Walker addition to the old Lehr & Wyatt machine. No one of these claims describes the manner in which the Walker addition will operate together with the old Lehr & Wyatt machine so as to make the 'new' unitary apparatus perform its designed function. Thus, the claims failed adequately to depict the structure, mode, and operation of the parts in combination."

[20]9th Circuit opinion, 146 F. 2d 817, 819, column 2.
[21]328 U.S. at p. 8.

The patent in *Walker* involved a combination of elements *all* of which were old (not true of 162, its stationary element, as found below, being new), because all that Walker had done was to add to a pre-existing combination an already-old device:

> "Walker's contribution which he claims to be invention was in effect to add to Lehr and Wyatt's apparatus a well-known device . . . The device added was a mechanical acoustical resonator." *Id.*, 329 U.S. pp. 6-7.

The means language he used was employed with respect to just what he had added, and, as it was only thus defined in terms of result, he clearly failed to comply with the rule of *Wabash*.

Recognition was taken[22] of the fact that the Court of Civil Appeals' opinion had stated "that the trial court had *found* 'that the only part of this patent constituting invention over the prior art is the "tuned acoustical means which performs the functions of a sound filter."' " The findings of the trial court there were thus in support of — instead of diametrically opposed to, as here — petitioner Halliburton's contention that "means" language had been employed to define the only novelty in the invention.

Without a similar finding here to the effect that the movable element or sub-combination called for in 162 constituted its only novelty, Halliburton is inapposite. Not only is there an absence of such finding in the record before you, but, as we have seen, the trial court find exactly the opposite:

"... the precise point of novelty in the inven-

[22] 329 U.S. @7.

tion did not reside in the movable element and its parts." (19th finding, R. 855).

In rejecting petitioner's very same contention below, the Fifth Circuit, after expressly noting that petitioner's counsel was seeking to confine the novelty of 162 "to the manner in which the valve is moved laterally and is seated or unseated", and that Bryan's attack on 162 was that its principal claim was "so broadly stated as to define the invention solely by statements of function and result," said:

> "We do not agree.
>
> "The novelty was not, as Bryan claims, the mechanism by which the tool could be laterally shifted to insert or retrieve the valve. The novelty, as the Court found, was the '***combination of co-acting elements of a side-pocket mandrel and shifting tool which left open the tubing bore and yet had full selective retrievability of flow-control units. Under prior gas-lift apparatus this had not been possible before.'." (254 F. 2d 193-4).

As further showing that the courts below did not miscomprehend the state of the law, as claimed by petitioner, we quote further from their opinions:

> "This contention as to invalidity was the principal point upon which the court expressed a desire for light at the conclusion of the evidence, as quoted at the outset of this memorandum. There can be no quarrel with the *principles* stated in the cases cited by defendant if they are applicable to the challenged claims." 144 F.Supp. 920.
>
> * * *
>
> "But where the novelty of the combination —

here the 'stationary element or receiving section consisting of a side-pocket mandrel as an integral part of the tubing string * * * capable of selectively receiving, seating and disgorging a flow-control unit * * lowered from the surface * * *' is adequately disclosed with definable limitations, other and well-known elements need not be described in structural detail." (254 F. 2d 194, par. 3).

3. *Warren v. Nashua*, 205 F. 2d 602

Unless the judgment below is in conflict with *Wabash* and *Halliburton*, it follows that it cannot be in conflict with *Nashua*, because all the First Circuit did there was to reannounce their rule and then hold that the inventor had sufficiently complied with it.

No matter how petitioner may attempt to twist the lucid holdings below, any fair appraisal of them exhibits that in neither instance was it held that Sec. 112 overrode *Wabash* and *Halliburton* by approving employment of "means" language to claim an invention only in terms of its result or a solution of a problem.

(We omit discussion of petitioner's other case with which the judgment below is said to be in conflict, *Application of Arbeit*, 206 F. 2d 947, because the Court of Customs and Patent Appeals, after belaboring the point, finally concluded:

"It is unnecessary for us to attempt a complete construction of Section 112, supra, at this time. It is sufficient to say that, in our opinion, it has no application to the facts of this case." *Id.*, p. 958.)

III.

The Petition Presents No Important Question of Federal Law

The holding below by the U. S. Court of Appeals for the 5th Circuit has no national significance, and petitioner's assertion (p. 7) "that issues of great moment to the public are involved" is but sham based on misinterpretation of such opinion and continued ignoring of what the Record shows with respect to the facts as found by the trial court.

Contrary to petitioner's contention, it is clear from the opinion of the Court of Appeals and the factual findings of the District Court that both courts were cognizant of the *Wabash* and *Halliburton* rule forbidding a patentee to claim his invention merely in terms of result by using functional language at the exact point of novelty. It is equally clear that such courts found the claims in issue here to be of the type dealt with by this Court in *Faulkner v. Gibbs* and accordingly valid under its ruling, rendering *Wabash* and *Halliburton* inapposite.

Manifestly, a review of the question of whether or not the claims in issue of respondent's Patent 162 were definite enough to comply with the case and statutory law would require this Court to first again determine the question of what was old and what was new at the time of such patent's conception and wherein its novelty lay. Such a third review of the evidence to weigh the soundness of the District Judge's findings of fact could serve no special or important purpose or serve the public interest.

The *Wabash*, *Halliburton* and *Faulkner v. Gibbs* opinions provide clear statements for the guidance of the public and the Federal Courts in their consideration of the issue, and it is not necessary to a decision here to determine the extent to which the new paragraph of Section 112 liberalized[23] the use of functional expressions in combination claims, because, as held below, the claims in issue complied with the rules existing prior to the addition of that paragraph in the 1952 Patent Act, and because such amendment can in no sense be said to have called for any stricter rule. Petitioner does not even so argue but only says that the amendment served to codify the preexisting case law on the point.

[23] "Commentary" by Examiner in Chief of the U. S. Patent Office constituting an "Introduction" to Title 35 of USCA at p. 25 of the first volume of that title.

CONCLUSION

Only private interests of private parties could be served by review of the case upon certiorari, and it is respectfully submitted that the petition should accordingly be denied.

Respectfully submitted,

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Charles L. Stephens
Of Counsel

June 25, 1958

CERTIFICATE OF SERVICE

Service of this BRIEF IN OPPOSITION to the PETITION FOR WRIT OF CERTIORARI has been made upon petitioner Thomas E. Bryan by mailing two copies thereof by regular United States mail, postage prepaid, to Oscar A. Mellin, 391 Sutter Street, San Francisco 8, California, counsel for petitioner, the same being the last address of Oscar A. Mellin known to respondent and its attorney, this 25th day of June, 1958.

Counsel for Respondent